SUPREME COURT OF THE UNITED STATES

October Term, 1941

No.————

GENERAL MOTORS CORPORATION,
Petitioner,

v.

CONWAY P. COE, Commissioner of Patents,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of Courts Below

The opinion of the Court of Appeals in this cause is reported in 120 F. (2d) 736. It is at pp. 455 to 457 of this record. The memorandum opinion of the District Court is at R. 89, and its findings of fact and conclusions of law at R. 90 to 92.

Jurisdiction

Jurisdiction to entertain this petition and review this cause is conferred upon this Court by Section 240 (a) of the Judicial Code, U.S.C., title 28, Sec. 347, as amended January 31, 1928 (45 Stat. 54).

The petition is timely, being within three months from and after the denial of the petition for rehearing (August 1st, 1941, R. 458). The judgment of the Court of Appeals is final.

Statement of the Case

The case presented by the petition is adequately set forth in the petition.

Specification of Errors

1. The Court of Appeals erred in holding that in an action under R.S. Sec. 4915 against the Commissioner of Patents substantial, well-founded doubt of lack of invention in the advance for which a patent is sought should be resolved against the applicant for patent.

2. The Court of Appeals erred in holding that in an action under R. S. Sec. 4915 against the Commissioner of Patents substantial, well-founded doubt of lack of invention in the advance for which a patent is sought should be resolved against the applicant for patent in a case in which the advance in addition to substantial novelty was concededly accompanied by such indicia of invention as "great importance", "great commercial success" and there is disagreement within and among the tribunals below.

3. The Court of Appeals erred in refusing to consider the inconsistency of the allowance of claim 92 and the disallowance of claim 109 and other claims in which are found the only novel and inventive feature upon which the allowance of claim 92 could have been predicated.

4. The Court of Appeals erred in refusing to consider the circumstance that there is no basis in the District Court's findings of fact for its conclusion that the claims involved in the appeal were unpatentable.

5. The Court of Appeals erred in not taking into account as an indication of invention with respect to the claims involved in the appeal the circumstance that many years, covering the period of intensive development of the automobile from its infancy to one of the great major industries elapsed between the dates of Rayleigh's treatise and Wilson's invention.

6. The Court of Appeals erred in holding that the desirability and need for Wilson's invention were not recognized and felt until shortly before Wilson produced it.

7. The Court of Appeals erred in holding that "The modification of the muffling chambers of Hooton, etc.,

so as to apply the teachings of Rayleigh and Stewart" did not clearly require "the uncommon talent of an inventor."

8. The Court of Appeals erred in holding that the uncommon talent of an inventor was not "clearly required to conceive of selecting — the particular sound waves which particular engines produced in such degree as to make it desirable to muffle them."

9. The Court of Appeals erred in not holding that the facts and circumstances which obtain in this case clearly demonstrate that the advance for which your petitioner is seeking a patent is of inventive character.

10. The Court of Appeals erred in not holding that your petitioner is entitled to a patent with the claims involved in the appeal and in not reversing the decision of the District Court.

Summary of Argument

The argument is summarized in the sections of the foregoing petition entitled *The Reasons Relied Upon for the Grant of the Writ.*

ARGUMENT

I.

The Importance of the Questions Presented by the Decision of the Court of Appeals.

The decision of the Court of Appeals in this cause unless revised by the Supreme Court will, we predict, eventually result in destruction of the patent system of this country. We say this with great seriousness without attempt to exaggerate. Immediately it will, in effect, nullify the right of appeal in actions against the Commissioner of Patents under R.S. Sec. 4915 and rout everything going beyond the Board of Appeals to the Court of Customs and Patent Appeals because under the rule applied by the Court of Appeals no appeal can succeed

unless the appellant can convince the Court that beyond a doubt the advance for which a patent is sought is of inventive character, and this confronted by the opposite decisions of the District Court and the Patent Office tribunals. Eventually the rule applied by the Court of Appeals in this cause will naturally, if it is approved by the Supreme Court by refusal to review the decision or by affirmance of the decision if it agrees to review it, be adopted by the other tribunals which deal with patent applications, viz., the United States District Court for the District of Columbia, the United States Court of Customs and Patent Appeals and the United States Patent Office. No reason exists for a different rule in the Court of Appeals of the District of Columbia than in these other tribunals as to resolution of doubt of lack of patentability. All of the other tribunals, except the lower Patent Office tribunal, are tribunals of review insofar as applications for patents are concerned.

The application by the other tribunals which deal with applications for patent of the rule applied by the Court of Appeals of the District of Columbia will mean that an applicant will be unable to obtain a patent unless he can prove beyond doubt that the advance for which he seeks a patent was of inventive character. Obviously this would be possible in few, if any, cases because unless the prosecuting of the application for patent is prolonged there will not be an opportunity for adequate exploitation of the invention before the prosecution is terminated. Under R.S. Sec. 4886 (U. S. C. Title 35, Section 31), as amended by the Act of August 5, 1939 (53 Stat. 1212) an application for patent must be filed within one year from the date that the invention was first put into public use or on sale in this country.*

The decision of the Court of Appeals in this cause makes it more difficult to get a patent than to sustain one. In a suit for infringement of a patent a substantial, well-founded doubt of lack of invention would be resolved

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*See Appendix.

in favor of the patentee by the indicia of invention which are not denied or questioned in this case.

In *Smith v. Goodyear Dental Vulcanite Company,* 93 U. S. 486, 495, 496, this Court said:

> "We do not say, the single fact that a device has gone into general use and has displaced other devices which had previously been employed for analogous uses establishes in all cases that the later device involves a patentable invention. It may, however, always be considered; and when the other facts in the case leave the question in doubt, it is sufficient to turn the scale."

In *Krementz v. The S. Cottle Company,* 148 U. S. 556, 560, 561, this Court said:

> "Yet, as was well said by Mr. Justice Brown in the case of Consolidated Brake-Shoe Co. v. Detroit Co., 47 Fed. Rep. 894, 'when the other facts in the case leave the question of invention in doubt, the fact that the device has gone into general use and has displaced other devices which had previously been employed for analogous uses, is sufficient to turn the scale in favor of the existence of invention.' "

In *Minerals Separation, Ltd. et al v. Hyde,* 242 U. S. 261, 270 this Court said:

> "The record shows not only that the process in suit was promptly considered by the patentee as an original and important discovery, but that it was immediately generally accepted as so great an advance over any process known before that, without puffing or other business exploitation, it promptly came into extensive use for the concentration of ores in most, if not all, of the principal mining countries of the world, notably in the United States, Australia, Sweden, Chile and Cuba, and that, because of its economy and simplicity, it has largely replaced all earlier processes. This, of itself, is persuasive evidence of that invention which it is the

purpose of the patent laws to reward and protect. *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 429, 430; *The Barbed Wire Patent*, 143 U. S. 275; *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486."

Other Supreme Court cases to the same effect are in the footnote.*

What must an applicant show in order to get a patent, if what has been shown in this case will not suffice? This is submitted as a fair question for the respondent to answer.

An erroneous grant of a patent is corrected by a Court in an infringement suit. The patentee may correct it by disclaimer. No Court in an infringement action can correct a wrong decision which refuses a patent which should have been granted. Patents are *prima facie* valid only, and error in granting is correctable upon putting the patent to test and otherwise. It would seem to be a common sense conclusion that the burden imposed upon an applicant to get a patent should be less and not greater than that of sustaining it.

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*Expanded Metal Co. v. Bradford, 214 U. S. 366, 29 S. Ct. 652, 53 L. Ed. 1034; Olin v. Timken, 155 U. S. 141, 15 S. Ct. 49, 39 L. Ed. 100; Seabury v. Am Ende, 152 U. S. 561, 14 S. Ct. 683, 38 L. Ed. 553; Keystone Mfg. Co. v. Adams, 151 U. S. 139, 14 S. Ct. 295, 38 L. Ed. 103; Duer v. Corbin Cabinet Lock Co., 149 U. S. 216, 13 S. Ct. 850, 37 L. Ed. 707; Grant v. Walter, 148 U. S. 547, 13 S. Ct. 699, 37 L. Ed. 552; Gandy v. Main Belting Co., 143 U. S. 587, 12 S. Ct. 598, 36 L. Ed. 272; McCreary v. Pennsylvania Canal Co., 141 U. S. 459, 12 S. Ct. 40, 35 L. Ed. 817; McClain v. Ortmayer, 141 U. S. 419, 12 S. Ct. 76, 35 L. Ed. 800; Magowan v. New York Belting etc. Co., 141 U. S. 332, 12 S. Ct. 71, 35 L. Ed. 781; Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177.

II.

The Questions Presented by the Decision of the Court of Appeals have not been passed on by this Court.

While as we have indicated in the foregoing section of this brief this Court has rendered decisions which the Court of Appeals should have considered controlling, it has not passed on the precise questions presented by the decision of the Court of Appeals, i. e. the rule of doubt in the case of applications for patents as distinguished from patents. And in view of the importance of these questions to inventors, industry and the country as a whole we submit this Court should pass on them.

III.

The Decision of the Court of Appeals is in Conflict with the Applicable Decisions of this Court.

In support of this statement we think it is necessary only to refer again to *Smith v. Goodyear Dental Vulcanite Company, Krementz v. The S. Cottle Company, Minerals Separation Ltd. et al v. Hyde,* supra, and the other decisions of this Court cited in Section I of this brief.

IV.

The Decision of the Court of Appeals on the Questions Presented by its Decision is in Conflict with the Decisions of all other Tribunals Which Deal With Applications for Patent.

In an *ex parte* proceeding to obtain a patent, upon appeal to the United States Court of Customs and Patent Appeals, that Court operates as in *In re Breer,* 55 F. (2d) 485. Breer had a novel and useful structure, leaving the question of invention to be determined under proper application of rules of law to the facts found. The Court said it was not unmindful of the fact that *both* of the Patent Office tribunals had held that it did not involve

invention; and then stated "the *well established rule* that in such cases we will not reverse their findings unless they are *manifestly wrong.*" Thus far there is agreement with the Court of Appeals in this cause when it says:

> "It is settled law of this court that we must sustain the findings of the Patent Office and District Court unless we think them *clearly wrong.*"

The Court of Customs and Patent Appeals in the Breer case found on the record "doubt as to lack of patentability of the claims in issue" the same as the Court of Appeals did herein. It then stated that the finding of such doubt required:

> "the application of the rule that where well-founded doubt of lack of patentability exists, such doubt should be resolved in favor of the inventor."

This is what we asked of the Court of Appeals. It found substantial, well-founded doubt, but then said that it was "obviously not law in relation to appeals from the District Court" to resolve such doubt in favor of the inventor.

The Patent Office, of course, follows the same rule as the Court of Customs and Patent Appeals and as did the Court of Appeals of the District of Columbia when it exercised the jurisdiction now exercised by the Court of Customs and Patent Appeals. To demonstrate we quote from the Court of Appeals decision in *In re Thomson*, 26 App. D. C. 425, 1906 C.D. 566, 120 O.G. 2756, in which the Court said at 1906 C.D. 571:

> "In case of ordinary doubt, *the policy of the patent system*, as customarily maintained in the Patent Office, has been to give the applicant the benefit thereof, because no absolute right or property is conferred by the grant of a patent (ex parte Fanshawe, C.D., 1891, 203; 57 O.G. 1127)."

In the actions under R.S. Sec. 4915 against the Commissioner of Patents which it tried, the United States District Court for the District of Maryland followed the rule of doubt. *Kaplan v. Robertson*, 50 F. (2d) 617 and *Berry v. Robertson*, 50 F. (2d) 915, in the latter of which at 50 F. (2d) 921 it is said:

> "Were there any doubt as to the patentability of the device here in issue, the Court would be compelled to resolve the doubt in favor of the plaintiff because of commercial success of the device as indicated by testimony which was not contradicted."

No reason exists for a different rule in the Court of Appeals for the District of Columbia than in the other tribunals which deal with applications for patents as to resolution of doubt of lack of invention.

As a matter of sound principle when, in a proceeding to obtain a patent, there is doubt as to lack of invention, the rule should be, as it always has been and still is except in part of the Court of Appeals of the District of Columbia, that the patent should be granted. Otherwise injury may be done for which there is no remedy. Doubtful questions as to invention and a determination of the questions will thus be left to the Court handling the matter in an infringement action, where all the evidence may be produced both for and against the invention in question. If the patent should not have been granted the Court says so and the error in granting is remedied. If a patent is refused that should have been granted, there is no remedy.

V.

The Decision of the Court of Appeals is in Conflict with its Decisions when it had jurisdiction of Appeals from the Patent Office and with its earlier Decisions in Actions Against the Commissioner of Patents under R. S. Section 4915.

When it had jurisdiction of appeals from the Patent Office the Court of Appeals for the District of Columbia uniformly held from time immemorial that substantial, well-founded doubt of lack of invention should be resolved in favor of the applicant. There are said to be upwards of fifty cases in which the Court enunciated the rule. In a footnote to Section 178 (page 139) 48 Corpus Juris cites more than thirty decisions in support of the rule. That the Court of Appeals of the District of Columbia considered the rule a general one of the law of patents and not merely one beneficently applied by particular Courts is clear from its reference to it in *In re Thomson*, supra, as "the policy of the Patent system."

The Court of Appeals of the District of Columbia recognized the rule in the following actions under R.S. Sec. 4915: *Thornton v. Coe*, 102 F. (2d) 247; *Carbide and Carbon Chemicals Corporation v. Coe*, 102 F. (2d) 236; *Battery Patents Corporation v. Coe*, 93 F. (2d) 220; and *Freyn Engineering Co. v. Coe*, 79 F. (2d) 134. In the case last mentioned the Court said:

> "Where a doubt exists as to the question of novelty, commercial success may justify the Court in resolving the doubt in favor of the applicant." *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 55 S. Ct. 449, 79 L. Ed. 997, decided Mar. 4, 1935."

In *Battery Patents Corporation v. Coe*, the Court of Appeals considered the rule of doubt in conjunction with the rule of presumption of correctness of the decisions of lower tribunals and arrived at the same conclusion as

did the Court of Customs and Patent Appeals in *In re Breer*, supra.

VI.

There is Disagreement Within the Court of Appeals Itself with Respect to the Proper Answer to the Questions Presented by its Decision in this Cause.

Late in 1938 two decisions were handed down by the Court of Appeals of the District of Columbia, one, *Carbide and Carbon Chemicals Corp. v. Coe, supra,* the other *Thornton v. Coe, supra.* In each, the majority of the Court on the merits of the case as had always been previous practice* and still is at times** applied proper rules of law to the facts and ruled that a patent should be granted.

There was a dissenting opinion in both cases.

Eleven months later in *Abbott v. Coe,* 109 F. (2d) 449 such dissenting opinions became the opinion of the Court, neither Justice of the majority opinion in *Carbide and Carbon Chemicals Corp. v. Coe* and *Thornton v. Coe* sitting in *Abbott v. Coe.*

In *Abbott v. Coe, supra,* the Court announced the rule:

> "The question for us is not whether in our opinion there was invention, but whether the finding there was none is consistent with the evidence."

The dissenting opinions in *Carbide and Carbon Chemicals Corp. v. Coe, supra,* and *Thornton v. Coe, supra,* mark the first attempt to avoid considering the merits of the case to determine whether or not a patent should be granted, followed, as the next step by *Abbott v. Coe, supra.*

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*Gasoline Products v. Coe, 87 F. (2d) 550; Hartford Empire Co. v. Coe, 87 F. (2d) 741; Otto v. Robertson, 66 F. (2d) 213; Lucke v. Coe, 69 F. (2d) 379; Wach v. Coe, 77 F. (2d) 113.

**Poulsen et al. v. Coe, 119 F. (2d) 188.

In subsequent cases involving *ex parte* applications for patent there was a persistent citing of *Abbott v. Coe, supra.* In *Wolf et al v. Coe,* 112 F. (2d) 857; *Eppensteiner v. Coe,* 114 F. (2d) 457; *Forward Process Co. v. Coe,* 116 F. (2d) 946; *Minnesota Mining & Mfg. Co. v. Coe,* 118 F. (2d) 593; and in this case. In the Minnesota Mining & Mfg. Co. case a dictum, that doubt previously resolved in favor of the applicant was obviously not law in relation to appeals from the District Court first appears. Such dictum would appear unnecessary, volunteered and out of place in the decision. For the decision of the majority was upon a factual basis, that the District Court should be affirmed because its decision was consistent with the evidence. The decision says nothing about invention being in doubt, as found by the Court in the present case.

Then such dictum in the Minnesota Mining & Mfg. Co. case was seized upon in this case to be a rule of law contrary to all previous authority of which there is an overwhelming weight of earlier decisions of the United States Court of Appeals for the District of Columbia and of other Courts.

Mr. Justice Stephens not sitting in Abbott v. Coe but sitting in *Minnesota Mining & Mfg Co. v. Coe,* in *Forward Process Co. v. Coe,* in *Wolf et al v. Coe* and in *Eppensteiner v. Coe,* by dissent in two of such cases and concurrence only in the result on the merits in the other two, has shown disagreement with such reversal of previous settled practice and overruling of settled law that doubt as to the presence or absence of invention should be resolved in favor of the inventor, leaving any doubt as to invention to be determined when the patent was put to a test, and not through error refusing patent protection and thus inflicting injury incapable of remedy.

There has been a turnabout and reversal of what the Court of Appeals for the District of Columbia has always previously followed as a settled rule of law, particularly when, from the evidence, the doubt is resolvable

by the proven and conceded indicia of invention, *Thornton v. Coe, supra.*

There is nothing settled *now* in the Court of Appeals of the District of Columbia regarding the application of rules of law to the fact findings made by the Court in appeals in actions under R.S. Sec. 4915 to determine the question of patentability.

The matter is in chaos. The Court is divided. There is no certainty and there is confusion which cries for settlement.

The dictum, without authority or reason, from *Minnesota Mining & Mfg. Co. v. Coe, supra,* stated as a rule of law, controlled the decision in this case. There is division and dissent in the Court. It is submitted that such division in connection with the revolutionary reversal of previously settled law should be an important and valid reason for the Supreme Court to grant certiorari for a review and settlement of the matter.

Unquestionably there should be certainty and not confusion and chaos and the element of chance involved in law applicable to actions under R.S. Sec. 4915, as in all actions. Today on an appeal from the District Court of the District of Columbia to its Court of Appeals in an action against the Commissioner of Patents to obtain a patent there is no such certainty and the *element of chance* is involved, namely, who is going to hear the appeal. Will the appeal be decided as in this case, or will it be a determination as in *Thornton v. Coe, supra, Otto v. Robertson, supra,* or as recently in *Poulsen et al v. Coe,* 119 F. (2d) 188 with doubt of lack of patentability resolved in favor of the applicant; particularly in cases of abundant concession and proof of legally recognized evidence of invention.

VII.

Conflict of Decisions Between the United States Court of Appeals for the District of Columbia and Another United States Court of Appeals on the Questions Presented by the Decision of the Former in this Cause is Altogether Unlikely.

The reason for this is that the Commissioner of Patents refuses to submit to the jurisdiction of any other United States District Court than the District Court for the District of Columbia. Mr. Robertson as Commissioner of Patents accepted service in the District Court of Maryland (*Kaplan v. Robertson* and *Berry v. Robertson, supra*) but that practice, once followed can be no longer used.

VIII.

The Decision of the Court of Appeals on the Questions Presented by its Decision in this Cause Results from Confusion of Two Entirely Separate and Distinct Rules of Law.

Sustaining the District Court and the Patent Office unless found clearly wrong is the rule in both the United States Court of Appeals for the District of Columbia and the United States Court of Customs and Patent Appeals. In other words, if there is merely doubt as to the *correctness of a decision* of the Patent Office or of the District Court the universal rule of appellate procedure is followed and there is affirmance.

We think that this is the rule followed by all appellate tribunals. There is a presumption that the lower tribunal is correct.

Doubt as to lack of *patentability* is found or not found upon the record of the case not by the Appellate Court alone, but by tribunals of original jurisdiction handling patent applications. The error in this case lies in an assumption that the rule that decisions of lower tribunals

are not to be reversed on mere doubts of their correctness and the rule with respect to doubt as to the presence or absence of invention are identical. The latter rule is another way of saying that if the absence of invention does not clearly appear, the patent is to be granted. Thus a finding by the Appellate tribunal that "the presence or absence of invention is doubtful in this case" establishes patentability. Patentability having been established, the presumption of correctness of the lower tribunal's refusal of patentability is overcome, such decision is clearly wrong, and there cannot be merely doubt as to its incorrectness. It is conclusively wrong.

The decision is based upon an obviously fallacious making identical two separate, distinct, consistent legal rules. It is a source of confusion and chaos and will continue to be until it is authoritatively corrected.

The rule of doubt is not a rule predicated on commiseration of inventors. It is founded on a sound legal principle. A patent application with the prescribed oath makes a prima facie case of invention.

48 Corpus Juris, 139, says

> "The oath of applicant is prima facie evidence of the invention."

Robinson on Patents in Section 123, (Volume 1, page 177) says:

> "But where legal novelty is present the law permits the alleged inventor to prove, if he can do so, that the invention has originated in his own inventive skill. For this his individual statement under oath, if not opposed by other evidence, may be sufficient. His long research and repeated trials may confirm, or his opportunity to imitate the arts or instruments of others may contradict his statement. The whole question is here open for the exhibition of any competent testimony; his own oath constituting prima facie proof, and *in a case of doubt the presumption always being in his favor.*"

The burden of showing lack of invention is thus put upon the Commissioner of Patents, and is not to be disregarded at any stage of any proceeding to obtain a patent. The rule of doubt is time tested, practical and workable. Any other rule would destroy the patent system by putting on applicants a burden that few, if any, could sustain.

CONCLUSION

It is very earnestly urged that the petition be granted. The questions presented and an authoritative answer thereto far transcend the interest of the petitioner in this cause. It is a matter, we submit, of vital public interest. Emasculation and substantial destruction of the patent system of the United States, we believe, will follow if the reversal of previously settled law and practice fully pointed out is not stopped, by a reversal of the United States Court of Appeals for the District of Columbia in this cause and a settlement of the serious uncertainty, confusion and chaos in the law now existing.

Very respectfully,

GENERAL MOTORS CORPORATION,

By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

October 16, 1941.

APPENDIX

R.S. Sec. 4886, as amended by the Act of August 5, 1939, reads as follows:

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."